



Attorney's Docket No. 2240P015D

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

12-47
In re Application of:

Gary S. Chisholm, et al.

Application No.: 09/049,161

Filed: March 26, 1998

For: METHOD AND APPARATUS FOR
PRECISE POSITIONING OF LARGE
STRUCTURES

Examiner: Olga Hernandez

Art Group: 3661

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DEC 02 2002

GROUP 3600

Assistant Commissioner of Patents
Washington, DC 20231-9998

REPLY BRIEF

Sir:

This reply Brief is submitted in triplicate in response to the Examiner's Answer of October 18, 2002. The Answer reveals a fundamentally flawed approach to the examination afforded this application and, further, fails to address points raised in the Appeal Brief which patentably distinguish the claimed invention from the cited reference. Either one of these grounds would be sufficient for the Board to reverse the present rejections of the claims. Together, they compel such action.

At paragraph 11, page 3, the Examiner's Answer asserts that because the cited reference, Anderson (U.S. Patent 6,032,084), discloses the same technique as is disclosed in the present specification, the present rejections should be maintained. Not only is this conclusion factually incorrect, it indicates a wholly inaccurate application of the law. The appropriate test for

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anticipation by a reference under 35 USC 102(e) is not whether the reference discloses the same technique as taught by the applicant in the specification of a patent application; the only test is whether the references teaches each and every aspect of the **claimed** invention. See, e.g., *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989) (“The identical invention must be shown in as complete detail as is contained in the . . . claim.”). By comparing the content of the reference with the teachings of the specification instead of the features of the claimed invention, the Examiner has failed to comply with the requirements of law in setting forth a rejection of the present claims. For this reason alone the Board should reverse the finding of anticipation.

In addition to being legally inadequate, the basis for the present rejections is factually inaccurate as well. To wit, the Anderson reference fails to disclose the display of an **attitude** of a structure as claimed. In the Examiner’s Answer, the “Microsoft Bookshelf Basics Dictionary” is cited as support for a definition of the term attitude that equates this term with position, and then states that Anderson discloses a system that provides the present position of an item. The undersigned is not familiar with the Microsoft work being cited and no copy of the reference has been provided by the Examiner. Moreover, and more importantly, there is no indication that this is an authoritative work that would be consulted by those of ordinary skill in the art.

In contrast, the Appeal Brief referred to Webster’s New World Dictionary as providing a definition for the term attitude as being different than position or orientation. This reference was first published in 1953 and at the time was hailed as “a great advance in American lexicography.” See, the Foreword to Webster’s New World Dictionary, Second College edition, p. vii (1982). The staff of contributing editors to this work includes distinguished university professors, researchers, senior staff members of national institutes and professionals from the fields of engineering, medicine and law. Simply put, if authoritative extrinsic evidence is to be sought out

in the matter of an appropriate definition of the term "attitude", the Examiner's choice pales in comparison to that previously cited.

Finally, and perhaps most tellingly, the Examiner's Answer fails to address the point raised in the Appeal Brief regarding the claimed feature of displaying a desired position of the structure. That is, not only do the claims recite the display of a present position, orientation and attitude of the structure, so too do the claims recite the display of a **desired** position, orientation and attitude of the structure. As indicated in the specification, this feature provides a visual reference for operators engaged in the task of moving the structure.

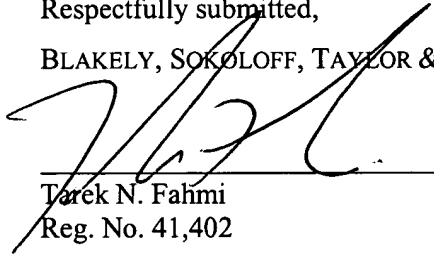
It has been repeatedly pointed out to the Examiner during prosecution of this application that no such display of a desired position, orientation and attitude is discussed or suggested in Anderson. This point is not disputed in the Examiner's Answer. Indeed, no analysis of the claim language vis-à-vis the cited reference whatsoever is provided. Without such an analysis and because the cited reference fails to teach each and every one of the claimed features of the present invention, the rejections of the claims should be reversed.

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Respectfully submitted,

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Dated: 11/20, 2002


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